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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/437,590	11/09/1999	BRANT L. CANDELORE	80398.P217	8195

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EXAMINER

WINTER, JOHN M

ART UNIT

PAPER NUMBER

3621

DATE MAILED: 05/21/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/437,590

Applicant(s)

CANDELORE, BRANT L. ✓

Examiner

John M Winter

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-72 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 10-18, 28-36, 46-54 and 64-72 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☒ Claim(s) 1-9, 19-27, 37-45, 55-63 are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☒ Interview Summary (PTO-413) Paper No(s). 1.
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_ 6) ☐ Other: \_\_\_\_\_

## DETAILED ACTION

### *Election/Restrictions*

Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claim 1-9, 19-27, 37-45, and 55-63, drawn to a method for receiving and descrambling data, classified in class 380 subclass 1.
- II. Claim 10-18, 28-36, 46-54, and 64-72 drawn to a method for controlling the recording and reproduction of digital content in class 375 subclass 1.

The inventions are distinct, each from the other because of the following reasons:

Inventions I and II are related as combination and subcombination. Inventions in this relationship are distinct if it can be shown that (1) the combination as claimed does not require the particulars of the subcombination as claimed for patentability, and (2) that the subcombination has utility by itself or in other combinations (MPEP § 806.05(c)). In the instant case, the combination as claimed does not require the particulars of the subcombination as claimed because a method for controlling the recording and reproduction of digital content, as stated in invention II has no dependency on a method for receiving and descrambling data as stated in invention I. The subcombination has separate utility such as descrambling data.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.

During a telephone conversation with Jim Salter on May 9, 2002 a provisional election was made without traverse to prosecute the of invention II, claims 10-18, 28-36, 46-54, and 64-72. Affirmation of this election must be made by applicant in replying to this Office action. Claims 1-9, 19-27, 37-45, and 55-63 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

Claims 10-18, 28-36, 46-54, and 64-72 have been examined.

### *Claim Rejections - 35 USC § 102*

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) do not apply to the examination of this application as the application being examined was not (1) filed on or after November 29, 2000, or (2) voluntarily published under 35 U.S.C.

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122(b). Therefore, this application is examined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

Claims 10-16, 18, 28-34, 36, 46-52, 54, and 64-70, 72 are rejected under 35 U.S.C. 102(b) as being anticipated by Muratani et al. (US Patent 6,061,451)

As per claim 10,

Muratani et al ('451) discloses a copy management method for controlling the recording and reproduction of digital content comprising:

receiving a digital bitstream including program data, said program data including system information and said digital content in a scrambled format; (Figure 2)

descrambling said digital content in a scrambled format to provide a first output including said digital content in a descrambled format; (Figure 2)

providing a second output including said digital content in the scrambled format; (Figure 2)

outputting said first output including said digital content in the descrambled format and the second output including said digital content in the scrambled format; (Figure 2)

receiving a plurality of access requirements, wherein each access requirement can descramble the program data, selecting at least one of the access requirements; (column 13, lines 57-67; column 14 lines 1-9)

storing the scrambled program data and the selected at least one access requirement. (Figure 2)

As per claims 28, 46, and 64, these claims are parallel with respect to claim 10

As per claim 11,

Muratani et al ('451) discloses the copy management method of claim 10, further comprising

receiving and recording said digital content of said second output in a scrambled format. (Figure 2)

As per claims 29, 47, and 65, these claims are parallel with respect to claim 11

As per claim 12,

Muratani et al ('451) discloses the copy management method of claim 10, further comprising:

demultiplexing said digital content from said program data;

decompressing said digital content in a descrambled format to a decompressed state.

(Figure 2)

As per claims 30, 48, and 66, these claims are parallel with respect to claim 12

As per claim 13,

Muratani et al ('451) discloses the copy management method of claim 10,

wherein said decompressing is executed in an MPEG decoder. (column 2, lines 50-58)

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As per claims 31, 49, and 67, these claims are parallel with respect to claim 13

As per claim 14,  
Muratani et al ('451) discloses the copy management method of claim 10,  
wherein said digital content is content contained in digital television transmissions.  
(column 20, lines 50-55)

As per claims 32, 50, and 68, these claims are parallel with respect to claim 14

As per claim 15,  
Muratani et al ('451) discloses the copy management method of claim 10,  
wherein said digital content is content downloaded from the Internet. (column 20, lines  
50-55)

As per claims 33, 51, and 69, these claims are parallel with respect to claim 15

As per claim 16,  
Muratani et al ('451) discloses the copy management method of claim 10,  
wherein said descrambling is carried out in a first conditional access unit. (column 5,  
lines 50-55)

As per claims 34, 52, and 70, these claims are parallel with respect to claim 16

As per claim 18,  
Muratani et al ('451) discloses the copy management method of claim 10, wherein said  
descrambling comprises:  
extracting a descrambling key included in said program data; and  
applying said descrambling key to said digital content in a scrambled  
format to provide said digital content in a descrambled format.

As per claims 36, 54, and 72, these claims are parallel with respect to claim 18

### ***Allowable Subject Matter***

Claims 17, 35, 53, and 71 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims and complying with double patenting statutes.

Any comments considered necessary by applicant must be submitted no later than the payment of the issue fee and, to avoid processing delays, should preferably accompany the issue fee. Such submissions should be clearly labeled "Comments on Statement of Reasons for Allowance."

### ***Conclusion***

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The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

- LaJoie et al. (US Patent 5,850,218) Inter-Active program guide with default selection control.
- Pinder et al (US Patent 6,105,134) Verification of the source of program information in a conditional access system.
- Wasilewski et al (US Patent 6,157,719) Conditional access system.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to John M Winter whose telephone number is (703) 305-3971. The examiner can normally be reached on M-F 8:30-6, 1st Fridays off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James P Trammel can be reached on (703)305-9768. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 746-5534 for regular communications and (703) 308-1396 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-3900.

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May 14, 2002



**JAMES P. TRAMMELL**  
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